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In the Supreme Court of the United States

OCTOBER TERM, 1948

No. —

LAWRENCE C. KINGSLAND, COMMISSIONER OF
PATENTS, PETITIONER

v.

BARRON-GRAY PACKING COMPANY

PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE DIS-
TRICT OF COLUMBIA CIRCUIT

The Solicitor General, on behalf of Lawrence C. Kingsland, Commissioner of Patents, prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia Circuit entered in the above-entitled case on October 12, 1948.

OPINIONS BELOW

The District Court of the United States for the District of Columbia did not render an opinion. The opinion of the United States Court of Appeals

for the District of Columbia Circuit (R. 12-15) has not yet been reported.

JURISDICTION

The judgment of the Court of Appeals was entered on October 12, 1948 (R. 15). The jurisdiction of this Court is invoked under 28 U. S. C. 1254(1).

QUESTION PRESENTED

Whether an applicant for a trade-mark who has been denied registration, after an opposition proceeding in the Patent Office, because of confusing similarity with a prior trade-mark, may seek review from the courts under Revised Statute 4915 by suit against the Commissioner of Patents alone, without notice to, and without joining as a defendant, the opposing party whose preexisting trade-mark formed the basis for the denial of the application.

STATUTE INVOLVED

Revised Statute 4915, as amended, 35 U. S. C. 63, reads as follows:

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy

by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

STATEMENT

The Barron-Gray Packing Company adopted and began the use of two trade-marks for fruit juices consisting of pictures of animated apricots and prunes. An application was made in the Patent Office for trade-mark registration. The Commissioner of Patents at first held these trade-marks to be registerable, and they were published in the Official Gazette of the United States Patent Office on December 24, 1940 (R. 2, 9).

Thereafter, opposition to the registration was filed in the Patent Office by Bruce's Juices, Inc., a Florida corporation, claiming that Barron-Gray's trade-marks were similar to its own registered marks, humanized representations of fruit holding tumblers of beverage. Barron-Gray filed answers to such oppositions and thereafter the Commissioner of Patents rendered a decision holding that some likelihood of confusion might exist in the concurrent use of Barron-Gray's trade-marks and Bruce's Juices' trade-marks, and refused registration (R. 2-3, 9).

Barron-Gray filed a bill in equity under R. S. 4915 in the United States District Court for the District of Columbia, against the Commissioner of Patents, alleging that its trade-marks are not similar to those of Bruce's Juices, and that its marks are not calculated to deceive or confuse the public (R. 1-9).

The Commissioner filed a motion to dismiss the suit on the ground that the opposer in the Patent Office was an indispensable party (R. 10). The district court sustained the motion (R. 10). On appeal, the Court of Appeals reversed and remanded the case for trial on its merits (R. 15).

The Court of Appeals held that the opposer is a proper but not an indispensable party. The reasons stated for this conclusion were, "Since the applicant has no power to compel the appearance of a non-resident opposer in a District of Columbia court unless the opposer chooses to appear and intervene, if it be held that the opposer is an indispensable party, as the district court has held in this case, it is obvious that the right of access intended by and provided for by Congress cannot be exercised except by sufferance. On the other hand, the Commissioner of Patents cannot be sued outside the District of Columbia without his consent. It is thus apparent that the net result of ruling that the non-resident opposer is an indispensable party to a 4915 action brought in this jurisdiction against the Commissioner alone would be to completely defeat the intent of Congress to afford the unsuccessful applicant for a trade-mark adequate access to the courts." (R. 13.)

SPECIFICATION OF ERRORS TO BE URGED

The Court of Appeals for the District of Columbia Circuit erred:

1. In holding that the successful opposing party in a trade-mark opposition proceeding is not an indispensable party to further proceedings in the courts under Revised Statute 4915.

2. In assuming that the Commissioner of Patents is an indispensable party to proceedings under R. S. 4915 in all cases.

3. In reversing the judgment of the district court.

REASONS FOR GRANTING THE WRIT

The court below has held, contrary to the decision of the Court of Appeals for the Third Circuit in *Century Dist. Co. v. Continental Dist. Co.*, 106 F. 2d 486, certiorari denied, 309 U. S. 662, that, in a proceeding brought under R. S. Section 4915 to review the action of the Commissioner of Patents in refusing to register a trade-mark after an opposition proceeding in the Patent Office, the Commissioner of Patents, and not the successful opposer in the opposition proceeding, is the indispensable party defendant. The result of this conflict has been, and will probably continue to be, to compel a party, in seeking judicial review under R. S. Section 4915 after a contested proceeding in the Patent Office, either to run the risk of having his action held fatally defective for lack of a necessary party or to initiate two actions in two separate forums on the same issues and seeking the same relief: one against the opposing party in the dis-

trict where he can be reached with process, the other in the District of Columbia where the Commissioner of Patents can be served. The conflict will affect patent cases, perhaps to an even greater extent than trade-mark matters.¹ Clearly, litigation proceeding simultaneously in two courts on identical issues affecting the same parties imposes an excessive burden on both the litigants and the judiciary, and contains always the possibility of a conflict in decisions susceptible of resolution by this Court alone. Yet unless the question as to the proper party against whom proceedings under Section 4915 are to be brought is set at rest by this Court, the conflict between the lower courts will continue to require such double litigation.

1. As respondent expressly conceded in its briefs below (Br. 15-16; Reply Br. 7), the rationale and result in the present case are in square conflict with *Century Distilling Co. v. Continental Distilling Co.*, 106 F. 2d 486 (C. A. 3). Both cases were brought under . . . S. 4915 by an unsuccessful applicant for a trade-mark who had been denied registration, after an opposition proceeding in the Patent Office, on the ground of confusing similarity between the trade-mark for which it was applying and one already held by its opponent. In the

¹ Although phrased solely in terms of patents, R. S. 4915 has long been held equally applicable to trade-marks. *American Steel Foundries v. Robertson*, 262 U. S. 209; *Baldwin Company v. Robertson*, 265 U. S. 168, 179.

Century case, however, the action was brought against the opponent; in this case, against the Commissioner of Patents. The defendant in the *Century* case moved to dismiss on the ground that the failure to join the Commissioner of Patents made the proceedings fatally defective for want of a necessary party. The district court which granted the motion was held to be in error by the appellate court. The action, the Court of Appeals for the Third Circuit held, should have been allowed to proceed even in the absence of the Commissioner; in short, that service of process upon the opponent was sufficient to confer jurisdiction on the court to review the denial of registration to the trade-mark. Here, on the other hand, the court below, rejecting the contention that a suit of this character may not be brought against the Commissioner of Patents alone, expressly assumes the indispensability of the Commissioner of Patents and predicates its decision on the ground that to hold the opponent also to be indispensable "would be to completely defeat the intent of Congress to afford the unsuccessful applicant for a trade-mark adequate access to the courts," (R. 13.) The opinion indicates that the court considers the Commissioner of Patents to be an indispensable party because otherwise the trade-mark applicant would be unable to secure effective relief. "The opposer," the court quotes from an earlier decision, "could not

act to carry out a decree granting such relief" (R. 14).

However, the statute clearly contemplates that actions will be maintainable in the absence of the Commissioner. It provides "In all cases when there is no opposing party a copy of the bill shall be served on the commissioner." Clearly, where there is an opposing party the Commissioner need not even receive notice of the suit, much less be made a party. Moreover, in suits to which the Commissioner is not a party, the statute specifically authorizes official action by him based on an adjudication in such private proceedings, and though not a party to the action, he is bound to respect such judgment.² *Barrett Co., et al. v. Ewing, Commissioner of Patents*, 242 Fed. 506 (C. A. 2), certiorari denied, 244 U. S. 661; *Cleveland Trust Co. v. Nelson, et al.*, 51 F. 2d 276 (E. D. Mich.). See, also, *Gandy v. Marble*, 122 U. S. 432. No greater deference is accorded by the Commissioner to judgments reached in proceedings under R. S. 4915 to which he is a party. Cf. *Hoover Co. v. Coe*, 325 U. S. 79.

The law as it has been developing in trade-mark cases in the federal courts is that the Commissioner of Patents is, or is not, an indispensable party to a proceeding under R. S. 4915 depending upon the character of the decision of the Patent Office which

² "And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law." *Supra*, p. 3.

the court is asked to review. If the trade-mark has been denied registration after opposition proceedings because it was descriptive (15 U.S.C. 85), and not because of any conflict with any other trade-mark, then the Commissioner of Patents is an essential party to any subsequent action. *Drackett Co. v. Chamberlain Co.*, 81 F. 2d 866 (C. A. 3). If, however, registration has been denied, as in this case, simply because of confusing similarity with a prior trade-mark (15 U.S.C. 85), then the action properly proceeds against the opposing party and not against the Commissioner of Patents. *Century Dist. Co. v. Continental Dist. Co.*, 106 F. 2d 486 (C. A. 3); *Speed Prod. Co., Inc. v. Tinnerman Prod., Inc.*, 73 U. S. P. Q. 181 (S. D. N. Y.)

Sound reason supports this distinction. When the trade-mark is denied because it conflicts with another's prior right, the successful opponent can be relied upon to protect whatever public interest may exist by bringing to the attention of the reviewing tribunal the factors militating against registration of the trade-mark. Where, however, the denial of registration is on a ground other than confusing similarity or priority, then self-interest will not coincide with public interest, and the Commissioner should be present to protect the public's right.

Moreover, proceedings under Section 4915 may proceed only "on notice to adverse parties." The

opponent, in a case such as this, in whose favor the Patent Office decided, has been held by at least one court to be an adverse party within the meaning of this statute. *Speed Prod. Co. v. Tinnerman Products, Inc.*, 73 U. S. P. Q. 181 (S. D. N. Y.); cf. *Drackett Co. v. Chamberlain Co.*, 81 F. 2d 866 (C. A. 3); *J. C. Eno (U. S.) Limited v. Coe*, 106 F. 2d 858 (C. A. D. C.). If the statute requires joinder of the opposing party, then to hold, as does the Court of Appeals for the District of Columbia Circuit, that the Commissioner is also indispensable will, in fact, act to deny adequate access to the courts.

These distinctions have been ignored by the court below, whose decision in the instant case crystallizes a continuing tendency to make the Commissioner a party to all actions under R. S. 4915 by applicants whose marks have been refused registration, and to burden the Commissioner with the defense of suits properly the major concern of the successful opposer in the Patent Office proceeding. *Alexandrine v. Coe*, 71 F. 2d 348 (C. A. D. C.); *Thorne, Neale & Co., Inc. v. Coe*, 143 F. 2d 155 (C. A. D. C.); *Tomlinson of High Point v. Coe*, 123 F. 2d 65 (C. A. D. C.); cf. *Speed Products Co., Inc. v. Tinnerman Products, Inc.*, 77 U. S. P. Q. 447 (S. D. N. Y.). Yet the Court of Appeals for the Third Circuit, a court of equal authority with the court below, has held to the contrary, and a lower federal court in another circuit, acting on the authority of the decision of that court, has per-

mitted a suit exactly comparable to this one to proceed in the absence of the Commissioner of Patents. *Speed Prod. Co., Inc. v. Tinnerman Products, Inc.*, 73 U. S. P. Q. 181 (S. D. N. Y.); cf. *Speed Products Co., Inc. v. Kingsland, Comm. of Patents, and Tinnerman Products, Inc.*, 77 U. S. P. Q. 447 (C. A. D. C.).

Meanwhile, private litigants, unable to resolve the conflict, are instituting parallel suits to preserve their rights. Speed Products Co., Inc., an applicant for a trade-mark, denied registration because of confusing similarity to the trade-mark of Tinnerman Products, Inc., instituted action in the District of Columbia against the Commissioner of Patents (*Speed Prod. Co., Inc. v. Kingsland, Comm. of Patents and Tinnerman Products, Inc., supra*) and in the Southern District of New York against its successful opponent. *Speed Prod. Co., Inc. v. Tinnerman Prod., Inc.*, 73 U. S. P. Q. 181. Other trade-mark applicants have done the same. See *Warsaw Brewing Corp. v. Kingsland, Comm. of Patents, and Atlantic Brewing Co.* (N. D. Ill., Civil No. 48 C. 1662) and *Warsaw Brewing Corp. v. Kingsland, Commissioner of Patents, and Atlantic Brewing Co.* (D. D. C., Civil No. 4621-48); *Botany Worsted Mills v. S. L. Peacock* (D. N. J., Civil No. 11479); *Botany Worsted Mills v. Commissioner of Patents* (D. D. C., Civil No. 2746-48); *Old Charter Distillery Co. v. Continental Distilling Corp.*, 65 U. S. P. Q. 395 (D. D. C.). This duplicate and confusing litigation can be ended only by a

definitive interpretation of the statute by this Court.

2. The broad grounds upon which the decision below rests make it applicable to all proceedings under R. S. 4915, patent as well as trade-mark cases. Under the reasoning of the court below, the Commissioner of Patents is an indispensable party to all such actions. Yet the well-established practice in patent cases has been to bring action against the opponent in the Patent Office proceeding, not joining the Commissioner. *Morgan v. Daniels*, 153 U. S. 120; *Butler v. Shaw*, 21 Fed. 321 (C. C. D. Mass.); *Hazeltine Corp. v. White*, 68 F. 2d 715 (C. A. 2); *Philadelphia Storage Battery Co. v. Zenith Radio Corp.*, 117 F. 2d 642 (C. A. 7); *Fessenden v. General Electric Co.*, 10 F. Supp. 846 (N.D. N.Y.); *Graham v. Teeter*, 25 Fed. 555 (C. C. E. D. Penn.). This decision casts a cloud on such proceedings, as well as on those involving trade-marks. The Lanham Trade Mark Act of July 5, 1946 (60 Stat. 427, 15 U.S.C. 1051-1127), which specifically provides that the Commissioner of Patents shall not be considered a necessary party to an *inter partes* proceeding under R. S. 4915 (60 Stat. 435, 15 U. S. C. 1071), may act to dispel some of the uncertainty created by this decision in future trade-mark cases,³ but it has no application to patent matters. Applicants for patents may well be com-

³ There is question, however, as to what proceedings involving opposers are "*inter partes*" for the purpose of proceedings under R. S. 4915.

pelled, as are those for trade-marks now, to institute duplicate litigation in the court of their opponent's domicile, in accordance with established practice, and in the District of Columbia, in conformance with the holding of the court below. In at least one case the defeated party in a patent interference has brought suit, under the authority of the opinion below, against the Commissioner of Patents in the District of Columbia and against his real adversary in California. *George E. Colby and Elmwood Braid Co. v. Comm. of Patents*, Civil Action No. 4605-48, filed November 9, 1948; *George E. Colby and Elmwood Braid Co. v. Joseph L. Hunter and Hunter Engineering Co.*, Civil No. 8882-B.H. (S. D. Cal.), filed November 15, 1948.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that this petition for a writ of certiorari should be granted.

PHILIP B. PERLMAN,
Solicitor General.

JANUARY 1949.